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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,466	12/12/2003	Takashi Sunamori	46441	8804
20736 7590 06/05/2007 MANELLI DENISON & SELTER 2000 M STREET NW SUITE 700 WASHINGTON, DC 20036-3307			EXAMINER NILAND, PATRICK DENNIS	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,466

Applicant(s)

SUNAMORI ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3 is/are allowed.
- 6) ☒ Claim(s) 2, 4, 6-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 05/29/07
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The amendment received 13 March 2007 has been made of record. Claims 1-4, 6-9 and 11 are pending.

2. Upon further consideration the indicated allowability of claims 4, 6-9 and 11 contained in the previous office action is withdrawn. Prosecution on the merits is hereby reopened.

3. Claims 7 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed ranges of viscosity are not supported in the specification as originally filed.

4. Claims 2, 4, 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 2 recites the limitation "liquid colorant precursor" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is therefore unclear at what stage "liquid colorant precursor" refers to or if it requires some non-claimed liquification step and calls into question whether the parent claim encompasses solid colorant precursors or if the colorant precursor is required to dissolve into a liquid. The scope of the claim is therefore unclear.

B. Claims 4, and by its dependency from claim 4, claim 8 recite an extinction coefficient that increases with polar group concentration. The claim fails to make clear that the polar group in question belongs to the resin admixed with the colorant, as is described in the specification, as

discussed in the prior interview with the applicant's representative. The applicant's representative appeared to agree that clarification of this issue was in order.

C. Each of claims 7 and 11 recite viscosity values without specifying the conditions under which the measurement was made. Temperature particularly affects this measurement.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4, 6, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 899288 A2 Sunamori et al..

EP '288 discloses methods for producing colorant dispersions. These methods include treating the colorant with an ion exchange process before admixture with a carboxyl group-containing polymer (abstract, paragraphs 33 and 39 and claim 8). The polymers disclosed by the reference are seen as inherently meeting applicants' limitation to carboxyl group concentration. The compositions of the reference are seen as inherently meeting applicants' viscosity limitations since no measurement conditions are specified. The limitation to heating residue of the colorant is seen as obtaining before mixture and is not seen as limiting the composition comprising colorant and resin binder. Applicants discussion at paragraph 18 of the pre-grant publication of the instant application makes clear that the property of increasing extinction coefficient with increasing polar group concentration is independent of any differences in method steps that may exist between the compositions of the application and those of the reference and, therefore, this

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behavior of the extinction coefficient would be expected to be inherent to the compositions of the reference.

7. Claims 1 and 3 are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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